

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

| APPLICATION NO. | F | ILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|------|--------------|----------------------|-------------------------|---------------------------------------|
| 10/613,589 07/02/2003 | | 07/02/2003 | Sakae Suda | 1232-5077 | 5542 |
| 27123 | 7590 | 11/24/2006 | | EXAMINER | |
| | | EGAN, L.L.P. | SHOSHO, CALLIE E | | |
| 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101 | | | • | ART UNIT | PAPER NUMBER |
| | , | | | 1714 | · · · · · · · · · · · · · · · · · · · |
| | | | | DATE MAILED: 11/24/2004 | 4 |

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief

| Application No. | Applicant(s) | |
|------------------|--------------|--|
| 10/613,589 | SUDA ET AL. | |
| Examiner | Art Unit | |
| Callie E. Shosho | 1714 | |

| Dororo the rining or an rippour Direr | Examiner | Art Unit | 1 |
|---|--|---|--|
| | Callie E. Shosho | 1714 | |
| The MAILING DATE of this communication appe | ears on the cover sheet with the c | orrespondence add | ress |
| THE REPLY FILED 10 November 2006 FAILS TO PLACE THIS | S APPLICATION IN CONDITION F | OR ALLOWANCE. | |
| 1. The reply was filed after a final rejection, but prior to or or this application, applicant must timely file one of the follor places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliantime periods: | n the same day as filing a Notice of wing replies: (1) an amendment, aff otice of Appeal (with appeal fee) in o | Appeal. To avoid aba idavit, or other evider compliance with 37 C | nce, which FR 41.31; or (3) |
| a) The period for reply expires 3 months from the mailing date b) The period for reply expires on: (1) the mailing date of this h | | in the final rejection, wh | ichover ie later. In |
| no event, however, will the statutory period for reply expire | ater than SIX MONTHS from the mailing | g date of the final rejecti | on. |
| Examiner Note: If box 1 is checked, check either box (a) or TWO MONTHS OF THE FINAL REJECTION. See MPEP 7 | 06.07(f). | | |
| Extensions of time may be obtained under 37 CFR 1.136(a). The date have been filed is the date for purposes of determining the period of extended and the purposes of determining the period of extended and the set forth in (b) above, if checked. Any reply received by the Office late may reduce any earned patent term adjustment. See 37 CFR 1.704(b) NOTICE OF APPEAL | ctension and the corresponding amount shortened statutory period for reply orig r than three months after the mailing da | of the fee. The appropr inally set in the final Offi | iate extension fee ice action; or (2) as |
| | aliance with 27 CED 41 27 must be | filed within two month | he of the date of |
| The Notice of Appeal was filed on A brief in comfiling the Notice of Appeal (37 CFR 41.37(a)), or any external a Notice of Appeal has been filed, any reply must be filed. | ension thereof (37 CFR 41.37(e)), to | avoid dismissal of the | ie appeal. Since |
| <u>AMENDMENTS</u> | . • | | |
| 3. The proposed amendment(s) filed after a final rejection, | | | ecause |
| (a) They raise new issues that would require further co | | TE below); | |
| (b) ☐ They raise the issue of new matter (see NOTE below) (c) ☐ They are not deemed to place the application in be | | ducina or simplifyina | the issues for |
| appeal; and/or | itter form for appear by materially re | ducing of ompinying | 110 100000 101 |
| (d) They present additional claims without canceling a | corresponding number of finally rej | ected claims. | |
| NOTE: see attachment. (See 37 CFR 1.116 and | | | |
| 4. The amendments are not in compliance with 37 CFR 1. | 121. See attached Notice of Non-Co | empliant Amendment | (PTOL-324). |
| 5. Applicant's reply has overcome the following rejection(s | | | |
| 6. Newly proposed or amended claim(s) would be a non-allowable claim(s). | | | |
| 7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro | | ill be entered and an | explanation of |
| The status of the claim(s) is (or will be) as follows: | | | |
| Claim(s) allowed: Claim(s) objected to: | | | |
| Claim(s) rejected: <u>1-3,5 and 7-11</u> . | | | |
| Claim(s) withdrawn from consideration: | • | | |
| AFFIDAVIT OR OTHER EVIDENCE | of the form of the date of filling a bi | lation of Ammont will m | at ha amtawad |
| The affidavit or other evidence filed after a final action, b because applicant failed to provide a showing of good ar was not earlier presented. See 37 CFR 1.116(e). | ut before or on the date of filing a N nd sufficient reasons why the affida | vit or other evidence i | s necessary and |
| 9. The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to showing a good and sufficient reasons why it is necessal. | overcome <u>all</u> rejections under appe ry and was not earlier presented. S | al and/or appellant fa See 37 CFR 41.33(d)(| ails to provide a (1). |
| 10. The affidavit or other evidence is entered. An explanation REQUEST FOR RECONSIDERATION/OTHER | on of the status of the claims after e | entry is below or attac | hed. |
| 11. The request for reconsideration has been considered b | ut does NOT place the application i | n condition for allowa | nce because: |
| 12. Note the attached Information Disclosure Statement(s). 13. Other: | (PTO/SB/08) Paper No(s) | | |
| | | Collin E Chasha | |
| | | Callie E. Shosho Primary Examiner Art Unit: 1714 | |

Application Number: 10/613,589

Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 11/10/06 has been fully considered but the amendment has not been entered given that it raises new issues that would require further consideration and search.

Specifically, the amendment raises new issues that would require further search given that while previously the present claims required composition comprising "solvent or dispersion medium", present claim 1 has been amended to recite that the composition requires "aqueous medium". This would require new searches given that while previously the claims were open to composition comprising <u>any</u> solvent or dispersion medium including organic solvent, the claims are now limited to those comprising aqueous medium.

Further, the amendment raises new issues that would require further consideration under 37 CFR 1.75(c) given that each of claim 3 and claim 5 are in improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, claim 3, which depends on claim 1, recites that the polymer compound is amphipathic and claim 5, which depends on claim 1, recites that the monomer unit of general formula (1) is incorporated in a hydrophobic block segment of the polymer compound while claim 1 recites that the polymer compound is an amphipathic block polymer compound including a hydrophobic block segment having a monomer unit represented by formula (1). Thus, claim 3 and claim 5 each fail to further limit the scope of the claim on which they each depend, namely, claim 1 given that claim 3 and claim 5 recite the same limitations already disclosed in claim 1.

Further, the amendment raises new issues that would require further consideration under 35 USC 112, second paragraph given that claim 1 in lines 5-6 recites that "the polymer

Application Number: 10/613,589

Art Unit: 1714

compound is an amphipathic block polymer compound including a hydrophobic block segment having a monomer unit represented by formula (1)" and also recites in line 17 "wherein the polymer compound is a block polymer". Thus, the scope of the claim is confusing given that there are two different recitations in claim 1 regarding the polymer compound and thus, it is not clear what the polymer compound encompasses.

It is noted that *if* the amendment filed 11/10/06 were entered, the amendment would overcome the rejection of record utilizing Sato et al. '904 (U.S. 2003/0232904). However, the amendment would not overcome the rejection of record utilizing Sato et al. '343 (U.S. 2003/0236343).

Specifically, applicants argue that Sano et al. '343 is not a relevant reference against the present claims given that while Sano et al. '343 disclose block polymer comprising hydrophobic block and hydrophilic block that is obtained from monomer of presently claimed formula (1), there is no explicit disclosure in Sano et al. '343 that the monomer is in the hydrophobic block segment of the polymer as required in the present claims.

On the one hand, however, given that Sano et al. disclose monomer identical to that presently claimed and block polymer comprising hydrophobic block and hydrophilic block as presently claimed, it is clear that the monomer would inherently also be part of the hydrophobic segment of the polymer as presently claimed.

On the other hand, given that Sano et al. disclose monomer identical to that presently claimed, which includes those that are hydrophobic, it is clear that such monomer would inherently be incorporated into the hydrophobic block segment of the polymer.

Art Unit: 1714

Thus, it is the examiner's position that even if the amendment were entered, Sano et al.

'343 would remain a relevant reference against the present claims.

Callie E. Shosho Primary Examiner Art Unit 1714

CS 11/20/06